

Attorney Docket: 01286
U.S. Application No. 10/026,704 Art Unit 2661
Response to July 13, 2007 Final Office Action

REMARKS

In response to the final Office Action dated July 13, 2007, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 19-31 are pending in this application. Claims 1-18 have been previously canceled without prejudice or disclaimer.

Rejection of Claims 19-31 under § 103 (a)

Claims 19-31 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2005/0262542 to DeWeese *et al.* in view of U.S. Patent 5,548,346 to Mimura *et al.* and further in view of U.S. Patent 5,671,267 to August, *et al.*

Claims 19-31, however, are not obvious over the combined teaching of *DeWeese*, *Mimura*, and *August*. These claims recite, or incorporate, features that are not taught or suggested by the combined teaching of *DeWeese*, *Mimura*, and *August*. Independent claim 19, for example, recites "a second output connected to an input of a second set top box using a back channel communications path" (emphasis added). Support for such features may be found at least at paragraphs [0009] and [0025]. Independent claim 19 also recites "the back channel communications path using an in-home wiring system that is different from the first input" (emphasis added). Support for such features may be found at least at paragraphs [0026] and [0028]. Independent claim 19 is reproduced below, and independent claim 30 recites similar features.

19. A set top box integrated with, or communicating with, a television, the set top box comprising:

a first input receiving broadcasted content from a service provider;

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a first output adapted to be received by the television, the first output sending the broadcasted content to the television;

a second input to receive message information from a user;

a second output connected to an input of a second set top box using a back channel communications path, the back channel communications path using an in-home wiring system that is different from the first input, the second output sending the message information to the second set top box, thus establishing a two-way intercom system with the second set top box; and

a back channel communications path that is different from the first input,

wherein the broadcasted content is processed for an audio channel and, when the message information has audible content, the message information is processed for another audio channel and a volume of the broadcasted content is reduced below a volume of the message information being played.

DeWeese, *Mimura*, and *August* cannot obviate all these features. *DeWeese* describes a television chat system in which set top boxes may communicate with a television facility. See U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraphs [0014], [0055], [0056], and [0059]. Real time audio communications may be exchanged during a television program. See *id.* at paragraphs [0011], [0015], [0071], and [0101]. These real time audio communications may be spoken into a microphone and sent to chat participants. See *id.* at paragraph [0105]. If bandwidth permits, the real time communications may have video content. See *id.* at paragraph [0015]. *Mimura* discloses a processor that analyzes a video signal and correspondingly processes an audio signal. See U.S. Patent 5,548,346 to *Mimura et al.* at column 14, lines 21-54. *August* teaches a video receiver that mutes an audio signal when an incoming call is received. See U.S. Patent 5,671,267 to *August, et al.* at column 2, lines 58-64.

Still, though, independent claims 19 and 30 are not obvious in view of the combined teaching of *DeWeese*, *Mimura*, and *August*. The combined teaching of *DeWeese*, *Mimura*, and *August* remains silent to “a second output connected to an input of a second set top box using a back channel communications path” (emphasis added). Even though *DeWeese* may describe a television chat system, *DeWeese*’s set top boxes communicate chat messages over a coaxial cable

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to a television facility. That is, *DeWeese*'s chat messages are sent over the same coaxial cable that also carries the television signals. As *DeWeese* explains, this coaxial cable "that eliminates[s] the need for additional communications paths separate from the paths that carry television signal broadcast channels for the transmission of chat communications." *DeWeese*, at paragraph [0014]. Because *DeWeese* communicates television signals and chat communications over the same coaxial cable, *DeWeese* entirely silent to "a second output connected to an input of a second set top box using a back channel communications path" (emphasis added). Because the combined teaching of *DeWeese*, *Mimura*, and *August* remains silent to at least these features, independent claims 19 and 30 cannot be obvious.

Independent claims 19 and 30 recite additional, distinguishing features. Independent claims 19 and 30 similarly recite "the back channel communications path using an in-home wiring system that is different from the first input" (emphasis added). Because the combined teaching of *DeWeese*, *Mimura*, and *August* communicate chat messages over a coaxial cable to a television facility, *DeWeese*, *Mimura*, and *August* remains silent to this in-home wiring system that connects the user's set top boxes. Independent claims 19 and 30, then, cannot be obvious.

Claims 19-31, then, are not obvious. Independent claims 19 and 30 recite many features that are not taught or suggested by *DeWeese*, *Mimura*, and *August*. Their respective dependent claims incorporate these same features and recite additional features. Claims 19-31, then, cannot be obvious, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

***DeWeese* "Teaches Away"**

DeWeese "teaches away" and cannot support the Examiner's *prima facie* cases. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert.*

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denied, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). **If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case.** See M.P.E.P. at § 2143.01 (emphasis added).

Any combination involving *DeWeese* requires an impermissible change to *DeWeese*'s principle of operation. The Office attempts to combine *DeWeese*'s "television chat system" with *Mimura*'s "TV conferencing system" and with *August*'s telephone handset. *DeWeese*'s principle of operation, however, must be impermissibly changed to support the Examiner's *prima facie* cases. As the above paragraphs explained, *DeWeese*'s principle of operation is to send chat messages over a coaxial cable to a television facility. As *DeWeese* explains, this coaxial cable "eliminates[s] the need for additional communications paths separate from the paths that carry television signal broadcast channels for the transmission of chat communications." *DeWeese*, at paragraph [0014]. Because *DeWeese* communicates television signals and chat communications over the same coaxial cable, *DeWeese*'s principle of operation must be changed to obviate "a second output connected to an input of a second set top box using a back channel communications path, the back channel communications path using an in-home wiring system that is different from the first input."

DeWeese must, therefore, "teach away" from the pending claims. *DeWeese*'s principle of operation must be changed to obviate "a second output connected to an input of a second set top box using a back channel communications path, the back channel communications path using an in-home wiring system that is different from the first input." The patent laws, however, forbid changing a principle of operation to support a *prima facie* case of obviousness. Because such changes are not permissible, *DeWeese* "teaches away" and cannot support the Examiner's *prima facie* cases. The Assignee thus respectfully requests removal of the § 103 (a) rejection of claims 19-31.

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If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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